

REMARKS

In the Office Action¹, the Examiner:

rejected claim 83 under 35 U.S.C. § 112, second paragraph;

rejected claims 1-7, 10, 11, 14, 15, 52-58, 61, 62, 65, 103, 106, 109, 112, 115, 118, 123, 124, and 129 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,853,634 to Davies et al. ("*Davies*");

rejected claims 8, 9, 59, and 60 under 35 U.S.C. § 103(a) as unpatentable over *Davies* in view of U.S. Patent Application Publication No. 2002/0082028 to Wittenkamp ("*Wittenkamp*");

rejected claims 12, 13, 63, 64, 125, and 127 under 35 U.S.C. § 103(a) as unpatentable over *Davies* in view of Official Notice;

rejected claims 17-24, 32, 35, 36, 39, 40, 68-75, 83, 86, 87, 90, 91, 104, 107, 110, 113, 116, and 119 under 35 U.S.C. § 103(a) as unpatentable over *Davies* in view of U.S. Patent No. 6,188,756 to Mashinsky ("*Mashinsky*");

rejected claims 25-31, 76-82, 117, and 120-122 under 35 U.S.C. § 103(a) as unpatentable over *Davies* in view of *Mashinsky* and U.S. Patent No. 6,535,596 to Frey et al. ("*Frey*");

rejected claims 33, 34, 84, and 85 under 35 U.S.C. § 103(a) as unpatentable over *Davies* in view of *Mashinsky* and *Wittenkamp*; and

rejected claims 37, 38, 88, 89, 126, and 128 under 35 U.S.C. § 103(a) as being unpatentable over *Davies* in view of Official Notice.

By this amendment, Applicants amend claims 1, 12-14, 17, 37-39, 52, 55-58, 63-65, 68, 72-75, 88-90, 103, 104, 106, 107, 109, 110, 112, 113, 118, 119, and 121-124, and cancel claims 15, 32, 35, 40, 83, 86, 91, and 129 without prejudice or disclaimer.

I. The Rejection of Claim 83 under 35 U.S.C. § 112, second paragraph

Claim 83 has been canceled, rendering the rejection moot.

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome this rejection, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to the rejection (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

II. The Rejection Under 35 U.S.C. § 102(e)

Applicants traverse the rejection of claims 1-7, 10, 11, 14, 15, 52-58, 61, 62, 65, 103, 106, 109, 112, 115, 118, 123, 124, and 129 under 35 U.S.C. § 102(e). Claims 15 and 129 have been canceled, rendering the rejection moot with respect to these claims.

Davies does not teach or even suggest each and every element of the claims. Claim 1, for example, recites a method comprising “sending contact information for the calling party to the preferred device of the user in the data format of the preferred device, when the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication” (emphasis added).

Davies discloses a “presence management system” that allows connections between watching and watched parties to be managed (*Davis*, abstract). *Davies’* presence management system chooses a best mode of communication between the parties, such as email or fax, based on preferences of the watched parties (*Davies*, abstract). *Davies’* also discloses a “mediation component” that enables messages in one format to be changed to another format, such as changing a voice message into an email (*Davies*, col. 17, lines 43-47).

The Office Action relies on *Davies’* mediation component in addressing certain recitations of independent claim 1 (Office Action at page 3). However, *Davies’* mediation component does not “send contact information for [a] calling party” to either the watched or watching parties. Further, *Davies’* mediation component does not do so when one device requires a different data format than another device. Therefore, *Davies* does not teach or suggest “sending contact information for the calling party to the preferred device of the user in the data format of the preferred device, when the

preferred device of the user requires a different data format than the device used by the calling party to initiate the communication,” as recited by independent claim 1 (emphasis added).

Accordingly, *Davies* cannot anticipate independent claim 1. Independent claims 52, 103, 106, 109, and 112, though of different scope from claim 1, recite subject matter similar to that set forth above with respect to claim 1. Claims 2-7, 10, 11, 14, 115, and 123 depend from claim 1, and claims 53-58, 61, 62, 65, 118, and 124 depend from claim 52, and are therefore allowable at least due to their dependence from allowable base claims.

III. The Rejections Under 35 U.S.C. § 103(a)

A. Claims 8, 9, 59, and 60

Applicants respectfully traverse the rejection of claims 8, 9, 59, and 60 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established. Claims 8 and 9 depend from claim 1, and claims 59 and 60 depend from claim 52. As discussed, *Davies* does not teach or suggest “sending contact information for the calling party to the preferred device of the user in the data format of the preferred device, when the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication,” as recited by independent claim 1 (emphasis added), or the similar recitations in independent claim 52.

Wittenkamp discloses a method for paging and selectively routing calls in a telecommunication environment (*Wittenkamp*, abstract). In *Wittenkamp*, the paging message may provide information regarding the identity of the person making the call (*Wittenkamp*, ¶ 25). However, *Wittenkamp* does not disclose or suggest that the paging

message provides “contact information” for the person making the call. Therefore, *Wittenkamp* does not teach or suggest “sending contact information for the calling party to the preferred device of the user in the data format of the preferred device, when the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication,” as recited by independent claim 1 (emphasis added) or the similar recitations of independent claim 52.

For the reasons discussed above, claims 8, 9, 59, and 60 are allowable over the cited references, at least due to their dependence from allowable base claims.

B. Claims 12, 13, 63, 64, 125, and 127

Applicants respectfully traverse the rejection of claims 12, 13, 63, 64, 125, and 127 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established. Claims 12, 13, and 125 depend from claim 1, and claims 63, 65, and 127 depend from claim 52. As discussed, *Davies* does not teach or suggest “sending contact information for the calling party to the preferred device of the user in the data format of the preferred device, when the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication,” as recited by independent claim 1 (emphasis added), or the similar recitations in independent claim 52.

In addressing claims 12 and 63, the Office Action takes Official Notice that “it would have been well known in the art ... [to] send the data format either along with a request or in response to a request ” (Office Action at page 7). However, the Official Notice does not constitute a teaching or suggestion of “sending contact information for the calling party to the preferred device of the user in the data format of the preferred

device, when the preferred device of the user requires a different data format than the device used by the calling party to initiate the communication,” as recited by independent claim 1 (emphasis added), or the similar recitations in independent claim 52, and therefore fails to cure the deficiencies of *Davies*.

Further, Applicants respectfully traverse the Official Notice, and assert that recitations of claim 12 such as “sending a request for the data format of the device used by the calling party” were not well-known in the art at the time of invention. Claim 12 depends from claim 1. The Office Action provides no support, beyond the mere allegations on page 7, for the assertion that it would have been well-known at the time of Applicants' invention to send a request “for the data format of the device used by the calling party” in combination with a method such as recited by claim 1. Indeed, the Office Action concedes that *Davies* fails to teach or suggest sending such a request (Office Action at page 7). Therefore, the Official Notice is improper and should be withdrawn. Should the Examiner maintain the Official Notice in the next Office Action, Applicants respectfully request the Examiner to provide documentary support, as required by M.P.E.P. § 2144.03(c).

For the reasons discussed above, claims 12, 13, 63, 64, 125, and 127 are allowable over the cited references, at least due to their dependence from allowable base claims.

C. Claims 17-24, 32, 35, 36, 39, 40, 68-75, 83, 86, 87, 90, 91, 104, 107, 110, 113, 116, and 119 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 17-24, 32, 35, 36, 39, 40, 68-75, 83, 86, 87, 90, 104, 107, 110, 113, 116, and 119 under 35 U.S.C. § 103(a). A

prima facie case of obviousness has not been established. Claims 32, 35, 40, 83, 86, and 91 have been canceled, rendering the rejection moot with respect to these claims.

Independent claim 17, for example, recites a method comprising “sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party” (emphasis added).

As discussed, *Davies* discloses a “presence management system” that includes a “mediation component” that enables messages in one format to be changed to another format, such as changing a voice message into an email (*Davies*, col. 17, lines 43-47). However, *Davies* does not disclose that the mediation component sends messages indicating that calling parties should contact users. Further, *Davies* is silent as to doing so when data formats differ between devices. Therefore, *Davies* does not teach or suggest “sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party,” as recited by independent claim 17 (emphasis added).

Mashinsky discloses a method and device that interrogates the availability of a called party before placing a communication from a calling party to a called party (*Mashinsky*, abstract). *Mashinsky* also discloses that the communication can be bridged across different networks (*Mashinsky*, col. 2, lines 40-42). However, *Mashinsky* also does not teach or suggest “sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the

preferred device of the user requires a different data format than the device used by the calling party," as recited by independent claim 17 (emphasis added).

Independent claims 68, 104, 107, 110, and 113, though of different scope from claim 17, recite features similar to those set forth above with respect to claim 17. Claims 68, 104, 107, 110, and 113 are therefore allowable for reasons similar to those presented above with regard to claim 17.

Claims 18-24, 36, 39, 69-75, 87, 90, 116, and 119 depend from one of independent claims 17 and 68, and these dependent claims are therefore allowable at least due to their dependence.

D. Claims 25-31, 76-82, 117, and 120-122

Applicants respectfully traverse the rejection of claims 25-31, 76-82, 117, and 120-122 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established. Claims 25-31, 76-82, 117, and 120-122 each depend from one of claims 17 and 68. As discussed, *Davies* and *Mashinsky* do not teach or suggest "sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party," as recited by independent claim 17 (emphasis added), or the similar recitations in independent claim 68.

Frey discloses a method and apparatus for processing a call from a calling party to a called party (*Frey*, abstract). *Frey* also discloses delivering the calling party's directory number to the called party (*Frey*, col. 9, lines 5-8). However, *Frey* does not disclose or suggest sending information to the calling party, or doing so when devices have different data formats. Therefore, *Frey* also does not teach or suggest "sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party," as recited by independent claim 17 (emphasis added), or the similar recitations in independent claim 68.

For the reasons discussed above, claims 25-31, 76-82, 117, and 120-122 are allowable over the cited references, at least due to their dependence from allowable base claims.

E. Claims 33, 34, 84, and 85

Applicants respectfully traverse the rejection of claims 33, 34, 84, and 85 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established. Claims 33, 34, 84, and 85 each depend from one of claims 17 and 68. As discussed, *Davies* and *Mashinsky* do not teach or suggest "sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party," as recited by independent claim 17 (emphasis added), or the similar recitations in independent claim 68.

As discussed above, *Wittenkamp* discloses a method for paging and selectively routing calls in a telecommunication environment, and a paging message may provide information regarding the identity of the person making the call (*Wittenkamp*, abstract and ¶ 25). However, *Wittenkamp* does not disclose or suggest that the paging message is sent to a calling party, or indicates that a user should be contacted at a preferred device. Therefore, *Wittenkamp* does not teach or suggest “sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party,” as recited by independent claim 17 (emphasis added) or the similar recitations of independent claim 68.

For the reasons discussed above, claims 33, 34, 84, and 85 are allowable over the cited references, at least due to their dependence from allowable base claims.

F. Claims 37, 38, 88, 89, 126, and 128

Applicants respectfully traverse the rejection of claims 37, 38, 88, 89, 126, and 128 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established. Claims 37, 38, 88, 89, 126, and 128 each depend from one of claims 17 and 68. As discussed, *Davies* does not teach or suggest “sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party,” as recited by independent claim 17 (emphasis added), or the similar recitations in independent claim 68.

The Office Action takes Official Notice that “it would have been well known in the art ... [to] send the data format either along with a request or in response to a request ” (Office Action at page 14). For reasons similar to those discussed above with respect to claims 12 and 63, the Official Notice is improper. Further, the Official Notice fails to cure the deficiencies of *Davies*, and does not constitute a teaching or suggestion of “sending information to the calling party indicating that the calling party should contact the user at the preferred device of the user, when the preferred device of the user requires a different data format than the device used by the calling party,” as recited by independent claim 17 (emphasis added), or the similar recitations in independent claim 68.

For the reasons discussed above, claims 37, 38, 88, 89, 126, and 128 are allowable over the cited references, at least due to their dependence from allowable base claims.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

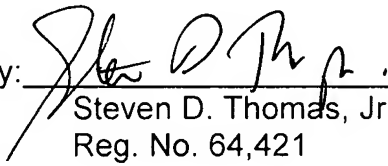
Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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By: _____


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